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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86051465
Applicant	Fashion Box S.P.A.
Applied for Mark	RS RED SEAL THE ORIGIN
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APPLICANT'S MOTION FOR RECONSIDERATION OF FINAL DECISION

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TABLE OF AUTHORITIES

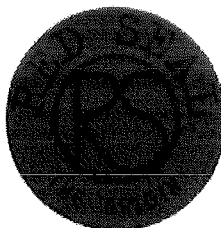
CASES

<i>Franklin Mint Corporation v. Master Manufacturing Company</i> , 212 USPQ 233, 234 (CCPA 1981) (citing <i>Massey Junior College v. Fashion Institute of Technology</i> , 181 USPQ 272 (CCPA 1974)).....	7
<i>In re Binion</i> , 93 USPQ2d 1531, 1534, 1535 (TTAB 2009).....	1
<i>In re Mighty Leaf Tea</i> , 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010).....	5
<i>In re TSI Brands Inc.</i> , 67 USPQ2d 1657, 1661- 62 (TTAB 2002).....	5
<i>In re Wilson</i> , 57 USPQ2d 1863 (TTAB 2001).....	6
<i>On-line Careline Inc. v. America Online Inc.</i> , 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).....	2
<i>Shen Mfg. Co. v. Ritz Hotel Ltd.</i> , 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004).....	2
<i>Steiger Tractor Inc. v. Steiner Corp.</i> , 221 USPQ 165 (TTAB 1984), <i>different results reached on reh'g</i> , 3 USPQ 2d 1708 (TTAB 1984).....	1
<i>Worthington Foods Inc. v. Kellogg Co.</i> , 14 USPQ2d 1577, 1599 (S.D. Ohio 1990).....	3

TBMP/TMEP/C.F.R. Sections

TBMP §§ 543, 544.....	1
TMEP § 1207.01(a)(i).....	2, 3
37 C.F.R. § 2.144.....	1

On October 6, 2015, the Board issued a non-precedential decision affirming the Trademark



Examining Attorney's refusal to register the mark in International Class 25 filed under U.S. Serial No. under Lanham Act Section 2(d) on the grounds that the same was confusingly similar to the registered mark RED SEAL in Class 18 registered under U.S. Reg. No. 3,978,673. Pursuant to 37 C.F.R. § 2.144 and TBMP §§ 543, 544, Applicant Fashion Box S.p.A. requests that the Board reconsider, and, as applicable, modify its decision. Applicant asserts that based on the evidence of record submitted by the Examining Attorney, and the applicable law, that the Board's ruling is in error and requires appropriate change. *Steiger Tractor Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *different results reached on reh'g*, 3 USPQ 2d 1708 (TTAB 1984).

- I. The Board erred in its analysis asserting that the goods included in the instant application would be considered "related" to the goods included in the cited RED SEAL mark

It is well-settled that in order to find a likelihood of confusion between two marks, it must be established that in instances where goods and/or services offered/to be offered by the respective parties are not identical, that the same must be considered to be "related". *See In re Binion*, 93 USPQ2d 1531, 1534, 1535 (TTAB 2009). Relatedness is established by establishing "that the goods and/or services of the applicant and the registrant are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead

to the mistaken belief that they originate from the same source.” TMEP § 1207.01(a)(i); *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000). In instances where the relationship between the goods is not readily apparent, it has been determined that in the absence of “substantial evidence” that relatedness may not exist. *See Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004). Applicant submits that the Board erred in its finding that the Class 18 items covered by the cited RED SEAL mark would be deemed related to the Class 25 clothing items included in the instant application because the record does not contain “substantial evidence” establishing such relatedness. The evidence considered by the Board in support of the refusal was in the nature of third party websites and third party registrations. Applicant submits that this evidence was not “substantial” and that as a result, it does not support a finding of relatedness between the relevant goods.

With respect to the third-party websites they are as follows:

- 1) An excerpt from the J. Crew website
- 2) An excerpt from the COACH website
- 3) An excerpt from the RALPH LAUREN website
- 4) An excerpt from the John Varvatos website
- 5) An excerpt from the BONOBO website
- 6) An excerpt from what appears to be the TORY Burch website

Applicant notes that the Tory Burch website does not contain any reference to men’s clothing, and as a result, should be given no weight when making an assessment regarding the men’s clothing covered by the instant application.

With respect to the remaining websites, Applicant submits that the Board erred in finding that these websites establish that the goods in question would be considered related because these

sites do not, on their own, establish that the respective goods are marketed in such a manner that they are necessarily “likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source”. TMEP § 1207.01(a)(i). This is the case for several reasons. First, the website evidence provided does not necessarily establish that any of the entities use the “house” mark on the goods themselves, they merely are websites that make reference to men’s wear in some capacity, without indicating how the marks are used on the goods themselves. The websites provided by the Examining Attorney are essentially online retail stores that contain a large variety of products including men’s wear, some of the items included in the cited Class 18 registration, as well as other items. For example, the John Varvatos site sells audio gear and photographs. The Ralph Lauren site contains references to various home goods. By the Board’s logic, it would appear that such home goods and audio equipment would be deemed related to clothing and/or the Class 18 goods covered by the cited registration as well by the mere act of being sold on the same website, which is a flawed presumption.

In fact, all the evidence provided by the Examining Attorney establishes is that the same goods are offered by the same entities in effectively the same “retail store”. It does not establish that these goods would necessarily be related. Based on the fact that the websites in question are effectively retail stores, the Board appears to be asserting that the mere fact that certain goods that are offered on the same website means that such goods would be considered related. To that end “...trademark law does not include a rule that all products sold ‘under the same roof’ with similar marks will engender confusion as to source, connection, or sponsorship.” *Worthington Foods Inc. v. Kellogg Co.*, 14 USPQ2d 1577, 1599 (S.D. Ohio 1990). In this case, because several of the third-party websites contain many other items on them, in addition to Applicant’s goods and the Class 18 goods covered by the cited registration, the existence of the sites provided by the

Examining Attorney that offer clothing and the referenced Class 18 goods thereon, will not immediately signal to the relevant consumers that the relevant goods would be related.

While it is true that the Board further relied on the third-party registrations that were based on use that were registered in conjunction with clothing as well as several of the items covered by the cited RED SEAL registration, this evidence does little to establish what the typical consumer's perception will be. This is the case because the typical consumer obviously is not aware of what is covered by various trademark registrations, and the mere existence of such goods included in the listed third party registrations does not speak to marketing conditions, or the way the various products would be sold. In addition, even though these registrations are based on use, it is unclear whether such marks are actually being used for such goods either now, or at the time the registrations were first obtained.

Accordingly, based on the fact that the mere sale of the relevant products in the same retail stores would not necessarily establish that customers would perceive that the relevant products would be associated with each other, as well as the questionable merit of the third party registration, Applicant submits that the meager evidence of record is not sufficiently "substantial" in order to support the Board's findings that the goods in question would be considered related.

II. The Board erred in finding that Applicant's highly stylized RS RED SEAL THE ORIGIN mark creates the same commercial impression as the registered RED SEAL word mark

In its decision the Board conceded that the marks differ in that Applicant's mark contains the RS initials, as well as the term "THE ORIGIN", but that the marks share RED SEAL wording. (Opinion pg. 9.) In affirming the Examining Attorney's refusal, the Board conceded that letters RS are in the largest font, and therefore, might be considered the dominant feature of Applicant's mark. (Opinion pg. 9.) Nevertheless, the Board further asserted that the letters RS do not

distinguish Applicant's mark from the registered mark because the RS lettering would be considered to be an abbreviation of the RED SEAL wording in Applicant's mark. (Opinion pg. 9.) However, the Board's reasoning behind this finding is somewhat specious. While it is true that the acronym for the wording RED SEAL would be RS, the Board erred with respect to its finding, and support for its finding, that the use of the lettering RS would have little impact on consumer's impression with respect to distinguishing between the marks.

As an initial point, the cases cited by the Board do not support a finding that Applicant's mark would be deemed confusingly similar to the registered mark. In *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) both the cited mark and the registered mark contained the lettering ML, whereas the registered mark also included the wording MARK LEES. In *In re TSI Brands Inc.*, 67 USPQ2d 1657, 1661- 62 (TTAB 2002) the applicant was endeavoring to register the stylized mark AK American Khakis, whereas the registered mark was comprised solely of the stylized lettering AK.¹ The Board's reliance on these prior holdings is misplaced and in error in light of the fact that in these two cited cases, the shared aspect of both the cited mark and the registered mark were the acronym, and the distinguishing element was the wording, whereas in the instant case, the shared aspect of the marks is the wording, not the acronym. In addition, in both of the cited cases, the "dominant" element of both the cited marks and the respective applicants' marks were deemed to be the acronym referenced therein, rather than the additional wording included in the respective ML MARK LEEES and AK American Khakis marks. By comparison, in the instant case, the Board conceded that RS lettering may be considered to be the dominant portion of Applicant's mark, and it is clear that the dominant portion of the respective marks differ. (Opinion pg. 9.) In order to support the Board's findings

¹ Notably, the TTAB found that there was no confusion between the AK and AK American Khakis mark.

that there would be a likelihood of confusion between the marks, a consumer would have to look at the large, dominant, RS lettering in the middle of Applicant's stylized design mark, which encompasses roughly half of the mark as a whole, subsequently see the much smaller RED SEAL wording, make a link that RS is an acronym for RED SEAL, ignore the wording "THE ORIGIN" and then perceive that commercial impression created by Applicant's mark is highly similar to the impression created by the RED SEAL word mark. In making this assertion, based on the simple facts and impression created by Applicant's stylized mark, the Board is imbuing a complicated thought process upon the typical consumer which is unlikely to occur in the real world, thus making confusion unlikely.

Further, the Board's ruling asserts that Applicant's mark essentially comprises a 'red seal' and that this image conjures up the same mental image as the RED SEAL wording comprising the registered RED SEAL mark. (Opinion pg. 10.) However, as already indicated, and conceded by the Board, the RS lettering contained in Applicant's mark might be considered to be the dominant aspect thereof. (Opinion pg. 9.) Therefore, even if one were to concede that Applicant's mark comprises a "red seal", as claimed by the Board in its decision, its mark is much more than just the image and the RED SEAL wording, as the dominant portion of the mark is not the design aspect, or the RED SEAL wording at all, but rather the RS lettering, which is the largest element thereof. Further to this point, Applicant submits that the cases cited by the Board for the proposition that confusion would be likely if one mark contained a pictorial representation of a particular term whereas the other mark to which the pictorial mark was being compared contained just the word itself are inapposite to the current situation. In all of the cases cited by the Board on pg. 10 of the Opinion, one of the marks was a word mark, whereas the other mark contained an image and either solely the shared word, or the shared word in addition to non-source identifying words such as "brand" in PINE CONE BRAND as in *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001). (Opinion

pg. 10.) The present situation is distinguishable from the various marks referenced by the Board in that the wording contained therein is not solely RED SEAL, but rather RS RED SEAL THE ORIGIN. As a result, because Applicant's mark contains this additional lettering in addition to RED SEAL, primarily the dominant RS lettering, the Board's assertion that Applicant's mark merely conjures up the same image as the cited RED SEAL mark is flawed, and in error, in that the Board failed to consider Applicant's mark as a whole when making an assessment regarding likelihood of confusion. *See Franklin Mint Corporation v. Master Manufacturing Company*, 212 USPQ 233, 234 (CCPA 1981) (citing *Massey Junior College v. Fashion Institute of Technology*, 181 USPQ 272 (CCPA 1974)).

III. CONCLUSION

Applicant respectfully submits that for the foregoing reasons the Board's decision to affirm the likelihood of confusion refusal for Applicant's mark against the cited RED SEAL word mark is in error based on the facts on the fact that the record does not contain "substantial evidence" establishing why the respective goods are related. In addition, based on the relevant law, the Board's decision to ignore the large differences between the marks is in error as well. Therefore, applicant hereby moves the Board to reconsider its prior decision, and reverse the likelihood of confusion refusal, thus permitting the instant RS RED SEAL THE ORIGIN & Design mark to proceed to publication.

Respectfully submitted,



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